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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,230	05/06/2005	Anthony John Watling	415.0011	3376
25534 7590 05/22/2008 CAHN & SAMUELS LLP 1100 17th STREET NW SUITE 401 WASHINGTON, DC 20036				
EXAMINER PARKER, FREDERICK JOHN				
ART UNIT 1792		PAPER NUMBER		
MAIL DATE 05/22/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,230

Applicant(s)

WATLING, ANTHONY JOHN

Examiner

Frederick J. Parker

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 32-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10 and 32-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Election/Restrictions

1. The Examiner has considered Applicants' arguments and decided to withdraw the restrictions and elections of species.

Specification

2. The amendments in response to the Objections to the Specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Objections

3. The cancellation of claim 20 in response to the Claim Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

4. Prior rejections are moot in view of cancellation of relevant claims.
5. Prior art rejections of the previous Office Action are withdrawn and replaced by those which follow as necessitated by amendments.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 32,35,42,44 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al US 2807552.

Regarding (a): a method of applying a mineral paint coating comprising a silicate solution including potassium, sodium, etc to provide surface protection (“modification”) of plaster, cement, masonry “and the like” is set forth, and includes the addition of pigments to such silicate paints to cause coloration (= tinting). Claim language never requires separate/successive/ and different coatings so the reference anticipates the claims.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 2-10, 32-40,42-50,52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooker 1991 in view of Scripture US 2306570.

The Hooker article details a method for modifying coloration of in situ masonry by the application of water-based multi-polymeric stains (“same as “tinting composition”) which are absorbed into the porosity of the masonry or mortar to change the coloration appearance of the masonry. The teachings recognize that the process is dependant upon the porosity / absorption characteristics of the product to which the colorant is applied: very hard, smooth materials do not color as well as porous, untextured materials. As shown in the figures the brick with mortar joints (masonry as defined by Applicants on page 5, Spec.) (per claim 2,5) have face surfaces which form an exposed (outer) surface. The result is an external masonry structure with a change

or correction in the coloration of the surface after the process. Ways to modify porosity of hard/non-porous materials which per se fail to accept coloration are not explicitly cited.

Scripture teaches a similar method of coloration of concrete, mortar, and stone materials using a coloring liquid, in which as in Hooker, it recognizes the need for the presence of porosity or transport of colorant into the material (page 3/left/10-15; right 56-66) and includes appropriate pretreatment of surfaces with “a **suitable acid**” (emphasis added) to open pores and allow penetration of colorant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hooker by incorporating the acid treatment of Scripture to open pores and allow penetration of colorant of building materials not accepting of colorant as disclosed by Hooker.

It is also the Examiner's position that sand per se is a naturally occurring material which may inherently be porous as is notoriously known in the building/ construction arts and therefore the use of porous sand to serve as the source of porosity for the prior art coloration processes would have been an obvious variation within the purview of one skilled in the art (see “Conclusion” for references to support inherent porosity of sand). Motivation for combining references under 35 USC 103 may be derived from the knowledge of persons of ordinary skill in the art, In re Rouffet 47 USPQ2d 1453 and MPEP 2143.01. It is well-established that the artisan is presumed to know something about the art apart from what the references disclose, In re Jacoby 135 USPQ 317; The conclusion of obviousness maybe made from “common sense” and “common knowledge” of the person of ordinary skill, In re Bozek 163 USPQ 545.

The wet-out tests become a semi-quantitative or qualitative optimization of what is already disclosed by the prior art, and provides a predictable outcome based upon the teachings of the prior art, i.e. higher porosity/ higher absorption/ greater coloration with depth; etc per claim 43.

The presence or use of multiple materials which have the same or different absorption reactivities, surface finishes (same as “textures” discussed in Hooker), color variations, color selection, etc per claims 4-10,15-16 are simply variations ascertainable from the prior art or within the purview of one of ordinary skill to achieve a greater variety of aesthetic looks. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431.

The final viscosity of the colorant liquid is clearly a function of porosity/ pore size that would have been determined by routine experimentation to meet the requirement of the prior art per clm 52. Where general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation, In re Aller 105 USPQ 233. Reaction conditions do not patentably distinguish over the prior art where they constitute merely modifications of an old process which one skilled in the art would be capable of making, In re Budde 138 USPQ 71.

Specific decorative variations of claims 2-10 are merely obvious variations within the purview of one skilled in the art with predictable and apparent outcomes: one uses a non-absorbent material, it won't tint; whether adjacent materials are recesses, raised, or flush is immaterial because the outcomes are again predictable based upon porosity. The variations of the claims are merely conventional aesthetic variations which have no material effect on the process.

Per claim 32, simply tinting the masonry structure fails to perceptibly later the feel/ texture, and often even the look of the masonry product, as evident from the prior art processes.

Fiber reinforced sheeting is masonry as defined on Applicants' Spec. page 5 and therefore inclusive in the "masonry" of the prior art.

10. Claims 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooker 1991 in view of Salts US 3799716.

Hooker is cited for the same reasons previously discussed, which are incorporated herein. Forming colored masonry comprising fire brick is not cited. Salts teaches the making of fire brick in which the green brick is spray coated with an aqueous glaze slurry which would modify exposed surfaces relative to coloration, the slurry comprising (see for example Table III) a dispersant (= surfactant), sand/ silica, oxide pigment, and cement, after which the coated brick is kiln fired under appropriate conditions. It is the Examiner's position that the use of flux/ cullet and clay would have been obvious formulation variations because they are well-known in the art to be glaze components, and which do not play a critical role in the novelty of the claimed process. Sand is expressly cited and would have encompassed dried sand.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Hooker on the bricks formed according to the method of Salts because of the expectation of causing a desired coloration of the brick materials of Salts.

11. Claims 41,51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooker 1991 in view of Scripture US 2306570 and further in view of Hermele US 4904709.

Hooker 1991 and Scripture are cited for the same reasons previously discussed, which are incorporated herein. An acrylic latex emulsion colorant coating is not cited.

Hermele teaches to apply pigmented/ colored acrylic emulsion stucco coatings to masonry surfaces to provide waterproofing, insulating, and decorative coatings. See col. 1, 14-24; col. 2, 5-14; abstract; col. 5, 8-27; etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hooker 1991 in view of Scripture by incorporating the colored/ pigmented acrylic emulsion coatings of Hermele as an obvious variation of providing a colored/ tinted coating on a masonry surface.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5110364 and US 4588443 each explicitly recite the inherency of porosity of sand.

Response to Arguments

Applicant's arguments and amendments are considered; the new rejections would appear to address them and therefore repeat of comments made above will be omitted for brevity.

It remains the Examiner's position the current claims represent variations and combinations of known steps for coloration of masonry surfaces, the claimed steps being obvious based upon the prior art and leading to wholly predictable outcomes, without any "surprising" or "unexpected" results.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frederick J. Parker/
Primary Examiner, Art Unit 1792

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fjp